

REMARKS

I. Summary of Office Action

Claims 13-15, 19, 21, and 27-39 were pending in the above-identified patent application.

The Examiner has alleged that claims 28-32 are directed to an invention that is distinct from the rest of the claims and has withdrawn claims 28-32 from consideration.

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) as failing to show every feature of the invention specified in the claims.

The Examiner has objected to the amendment filed on February 20, 2009 under 35 U.S.C. § 132(a) as allegedly introducing new matter.

The Examiner has rejected claims 21, 27, 36, and 37 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as invention.

The Examiner has rejected claims 13, 14, 21, 27, 33, 35-37, and 39 under 35 U.S.C. § 102(b) as being anticipated by the Rosenberg non-patent literature document entitled "The Dilemma of Pilonidal Disease: Reverse Bandaging for Cure of the Reluctant Pilonidal Wound" ("Rosenberg").

The Examiner has rejected claims 13-15, 19, 21, 27, 33-37, and 39 under 35 U.S.C. § 102(e) as being anticipated by DeMarco U.S. Patent No. 6,257,951 ("DeMarco").

The Examiner has rejected claims 13-15, 19, 21, 27, 33-37, and 39 under 35 U.S.C. § 102(c) as being anticipated by Valentin U.S. Patent No. 6,231,424 ("Valentin").

The Examiner has rejected claims 13-15, 19, 21, 27, 33-37, and 39 under 35 U.S.C. § 102(b) as being anticipated by Diaz U.S. Patent No. 4,992,074 ("Diaz").

The Examiner has rejected claim 38 under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg, DeMarco, Diaz, or Valentin.

II. Summary of the Reply

Applicant has amended claims 13-15, 21, 27, 33-36, and 38-39 to more particularly define the claimed invention.

Applicant has added new claims 40-44. No new matter has been added by these new claims and they are fully supported by the originally filed application.

The Examiner's objections and rejections are respectfully traversed.

III. Telephonic Interview Summary

On July 6, 2009 a telephone interview took place between the Examiner and the undersigned. The undersigned wishes to thank the Examiner for the courtesies extended during this telephone interview.

Generally, the Examiner and the undersigned discussed the Rosenberg, DeMarco, Diaz, and Valentin references. The Examiner indicated that he felt the DeMarco, Diaz, and Valentin references were not substantial. The Examiner also indicated that an Affidavit may be helpful in overcoming the 35 U.S.C. § 102(b) rejection with respect to Rosenberg.

The Examiner and the undersigned also discussed a version of new, independent claim 40. However, the Examiner did not take any position regarding new, independent claim 40.

IV. Applicant's Reply to the Election Requirement

The Examiner alleged that claims 28-32 are directed to an invention that is "distinct" from the rest of the claims and thus are properly restrictable. The Examiner then withdrew claims 28-32 from consideration and made the restriction requirement final.

Applicant respectfully traverses the restriction requirement and constructive election. Applicant respectfully notes that in the Reply to Office Action dated February 20, 2009, applicant provided arguments as to why claims 28-32 were not distinct. These arguments were not addressed by the Examiner, nor did the Examiner provide "reasonable examples that recite material differences" to show that claims 28-352 are distinct, as required by the Examiner in MPEP § 806.05(e).

Nonetheless, in the interest of advancing prosecution, applicant hereby confirms, with traverse, the constructive election of claims 13-15, 19, 21, 27, and 33-39. Applicant respectfully reserves the right to pursue the subject matter of the non-elected claims in one or more continuation applications, divisional applications, or both.

V. Applicant's Reply to the Drawings Objection

The Examiner has objected to the drawings under 37 C.F.R. § 1.83(a) as failing to show every feature of the invention specified in the claims. In particular, the Examiner argued that the "rubber separation knobs" are not shown in the drawings.

In response, applicant has amended FIG. 3 to show rubber separation knob 38. No new matter has been added by this amendment and it is fully supported by the originally-filed application. For example, see page 14, lines 24-27 and page 12, lines 3-6 of applicant's originally-filed specification.

For at least the above reason, applicant respectfully submits that the drawings show every feature of the invention specified in the claims, and requests that the objection to these drawings be withdrawn.

VI. Applicant's Reply to the Amendment Objection

The Examiner has objected to the amendment filed on February 20, 2009 under 35 U.S.C. § 132(a) as allegedly introducing new matter. In particular, the Examiner alleged that the "rubber separation knobs" of the February 20, 2009 amendment are not supported by the original disclosure. Applicant respectfully traverses this objection.

The subject matter, "rubber separation knobs," is supported by the originally-filed application and does not introduce new matter. For example, applicant's originally-filed specification describes that "belt portions 18 and 20 [of garment 10] may also include frictional members (not shown), such as small rubber knobs that further enhance the separation action of the belts" (applicant's specification, page 12, lines 3-6). As another example, applicant's originally-filed specification describes that "tape 30 may also include a series of attachment members (not shown) at the end . . . such as the rubber knobs described above with respect to garment 10" (applicant's specification, page 14, lines 24-27).

For at least the above reason, applicant respectfully submits that the amendment filed on February 20, 2009 does not introduce new matter and is fully supported by the originally-filed application. Accordingly, applicant respectfully requests that this objection to the amendment be withdrawn.

VII. Applicant's Reply to the 35 U.S.C. § 112,
Second Paragraph Rejection

The Examiner has rejected dependent claims 21, 27, 36, and 37 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as invention. In particular, the Examiner argued that it is unclear what structure is intended to be recited by the term "pre-formed" in claim 21. The Examiner further argued that it is unclear what further structure is recited by claims 27, 36, and 37.

In response, applicant has amended claims 21, 27, and 36. Applicant respectfully submits that these claims, as amended, particularly point out and distinctly claim the subject matter which applicant regards as invention. Accordingly, applicant respectfully requests that the 35 U.S.C. § 112, second paragraph rejection of claims 21, 27, and 36 be withdrawn.

Applicant has cancelled claim 37. Accordingly, the 35 U.S.C. § 112, second paragraph rejection of claim 37 is moot, and applicant respectfully requests that this rejection be withdrawn.

VIII. Applicant's Reply to the 35 U.S.C. § 102(b)
Rejection With Respect to Rosenberg

The Examiner has rejected claims 13, 14, 21, 27, 33, 35-37, and 39 under 35 U.S.C. § 102(b) as being anticipated by Rosenberg. The Examiner's rejection is respectfully traversed.

Applicant's invention, as defined by independent claims 13 and 33, is directed to a strip of material that is operable to separate swollen tissue from non-swollen tissue. For example, the swollen tissue may be caused by a hemorrhoids ailment (*See, e.g.*, applicant's specification, page 9, lines 12-15). The strip of material is "substantially planar and is crescent shaped." In other words, if applicant's claimed invention were laid down on a surface, it could lie flat against this surface and appear crescent shaped from a top view (*See, e.g.*, applicant's FIG. 3). The strip of material has a length that is at least twice as long as its width. An adhesive is applied to at least one side of the strip of material such that "said strip and said adhesive are

operable to be applied to a person's body and to separate said swollen tissue from non-swollen tissue when applied."

Nowhere does Rosenberg show or suggest applicant's claimed invention. Rosenberg is directed to an "adhesive strapping" used for treating a pilonidal wound (*See, Rosenberg, page 291, line 6*). This adhesive strapping is only described by a single picture and a single passage of Rosenberg. The picture shows a straight strapping (*See, Rosenberg, FIG. 1*). The passage reads:

a patient was then asked to strap his buttocks in a reverse direction, that is, wide adhesive strapping was utilized on either side of the wound, stretching outward and crossing on the abdomen in the front (*Rosenberg, page 291, lines 4-8*)

Apart from this citation and this picture, Rosenberg does not describe the shape or structure of its adhesive strapping. As such, nowhere does Rosenberg show or suggest the unique shape and structure of applicant's claimed invention, such as a strip of material that is "crescent shaped," as required by applicant's independent claims 13 and 33.

This unique shape and structure of applicant's claimed invention can provide a wide range of benefits for a user, and these benefits have not previously been met by the prior art. For example, applicant hereby makes of record in this application four different 37 C.F.R. § 1.132 Affidavits, one Affidavit from Dr Steinhagen, one from Dr. Freed, one from Dr. Curet, and one from Mrs. Suárez. These Affidavits attest to, for example, the many benefits of the claimed invention, the differences between Rosenberg and the claimed invention, and the long felt need that has been met by the claimed invention. Copies of these C.F.R. § 1.132 Affidavits are enclosed with this Reply to Office Action.

As shown by these Affidavits, the claimed invention has a unique shape and structure not shown by Rosenberg. Because of this unique shape and structure, inflamed tissue caused by a hemorrhoid can be lifted at a specific angle that follows the anatomy of a patient's body. This lifting can further distract the buttocks to keep the skin in the perianal area from rubbing the inflamed tissue, thus providing immediate and rapid relief of the hemorrhoidal pain. Additionally, by lifting at this specific angle, the claimed invention provides enhanced healing effects to the hemorrhoid. The healing of the hemorrhoid may be so pronounced that a patient,

who otherwise would have needed to undergo surgery without the claimed invention, can avoid this surgery. Avoiding surgery may, for example, significantly reduce health care costs, allow a patient to avoid missing work, and allow a patient to avoid the pain and inconvenience cased by surgery. As another benefit, the unique structure of the claimed invention can also provide this enhanced healing without requiring a patient to use other medications, such as cortisone creams or Peranex. This may not only provide cost savings for a patient, but can help a patient avoid the potential irritation and pain that can be caused by these medications. Moreover, as the unique structure of the claimed invention follows a user's anatomy, the claimed invention can be worn without any uncomfortable pulling of the skin or muscles. This allows a user to freely sit, stand, walk, and otherwise continue their daily, routine life. Rosenberg does not show the claimed invention's unique structure and thus does not produce any of these above-mentioned benefits.

Moreover, not only does Rosenberg not show or suggest the unique shape and structure or provide the benefits of applicant's claimed invention, but Rosenberg's structure is designed to be applied to a different part of the body. The purpose of Rosenberg is also different. Rosenberg is designed to treat a post-operative pilonidal surgical wound. The claimed invention, on the other hand, has a structure that can reduce inflammation in the anal area, can provide immediate relief of hemorrhoidal pain, and can assist the hemorrhoid in rapidly healing.

Furthermore, these Affidavits show that applicant's claimed invention is not currently available by anyone else, and that it is not obvious for anyone to create this claimed invention from what was existing at the time the application was filed. Rather, as Dr. Freed attests, "I know of no prior technology that is similar to the claimed invention or that provides relief of hemorrhoidal symptoms in the same manner." Moreover, the claimed invention fulfills a long-felt but unmet need by, for example, providing a user-friendly and cheap alternative for healing even the most severe hemorrhoids. Indeed, as attested to by Mrs. Suárez, the claimed invention may heal even the most severe type of hemorrhoid within three days, when such a hemorrhoid would otherwise have required inconvenient and painful surgery. Furthermore, by experiencing the relief of hemorrhoidal pain and enhanced healing provided by the claimed invention, a user can immediately return to work. Without the claimed invention, the user may have needed to take sick days because of the hemorrhoid. As these examples show, the claimed invention fulfills a long-felt but unmet need and can provide many benefits to its users.

For at least the foregoing reason, applicant respectfully submits that independent claims 13 and 33, and any claims depending therefrom, are patentable over Rosenberg. Accordingly, applicant respectfully requests that the 35 U.S.C. § 102(b) rejections of 13, 14, 21, 27, 33, 35-37, and 39 with respect to Rosenberg be withdrawn.

IX. Applicant's Reply to the 35 U.S.C. § 102 Rejections With Respect to DeMarco and Valentin

The Examiner has rejected claims 13-15, 19, 21, 27, 33-37, and 39 under 35 U.S.C. § 102(e) as being anticipated by DeMarco. The Examiner has further rejected claims 13-15, 19, 21, 27, 33-37, and 39 under 35 U.S.C. § 102(c) as being anticipated by Valentin. Applicant assumes the Examiner meant to cite 35 U.S.C. § 102(e) with respect to the Valentin rejection. Clarification is therefore respectfully requested. The Examiner's rejections are respectfully traversed.

Applicant's independent claims 13 and 33, as amended, are directed to apparatuses for relieving discomfort caused by swollen tissue ailments. Each apparatus includes, among other thing, a strip of material that is crescent shaped and is substantially planar.

DeMarco and Valentin, whether taken alone or in combination, fail to show or suggest all features of applicant's claimed invention. In particular, DeMarco and Valentin fail to show or suggest a strip of material that is "substantially planar," as required by applicant's independent claims 13 and 33.

DeMarco and Valentin are each directed to strapless bras (*See, e.g.*, DeMarco, column 2, lines 49-50 and Valentin, column 2, lines 57-59). As shown by DeMarco and Valentin and as is well-known in the art, the strapless bras are curved in three dimensions (*See, e.g.*, DeMarco, FIG. 2, and Valentin, FIG. 2). Accordingly, DeMarco and Valentin fail to show or suggest a strip of material that is "substantially planar" as required by applicant's independent claims 13 and 33.

For at least the foregoing reason, applicant respectfully submits that independent claims 13 and 33, and any claims depending therefrom, are patentable over DeMarco and Valentin, whether taken alone or in combination. Accordingly, applicant respectfully requests

that the 35 U.S.C. § 102 rejections of claims 13-15, 19, 21, 27, 33-37, and 39 with respect to DeMarco and Valentin be withdrawn.

IX. Applicant's Reply to the 35 U.S.C. § 102(b)
Rejections With Respect to Diaz

The Examiner has rejected claims 13-15, 19, 21, 27, 33-37, and 39 under 35 U.S.C. § 102(b) as being anticipated by Diaz. The Examiner's rejection is respectfully traversed.

Applicant's independent claims 13 and 33, as amended, are directed to apparatuses for relieving discomfort caused by swollen tissue ailments. Each apparatus includes, among other things, a strip of material that is substantially planar, that is crescent shaped, and that has a length and a width. The length of the strip of material is "at least twice as long as the width."

Diaz is directed to a self-supporting bra (*See, e.g.*, Diaz, column 1, lines 48-50). This self-supporting bra includes form 10 (e.g., a bra cup) and self-adhesive strip 22 (*See, e.g.*, Diaz, FIG. 5). Self-adhesive strip 22 is combined with form 10 to hold form 10 against a user's body (*See, e.g.*, Diaz, column 3, lines 37-40).

Diaz fails to show or suggest all features of applicant's claimed invention. In particular, Diaz fails to show or suggest a strip of material in which the length is at least twice as long as the width, as required by applicant's independent claims 13 and 33. In direct contrast, self-adhesive strip 22 of Diaz requires a length that is 1.7 times longer than the width (*See, e.g.*, Diaz, column 3, lines 48-50).

Moreover, neither does form 10 nor the combination of form 10 and self-adhesive strip 22 of Diaz show or suggest a structure in which the length is at least twice as long as the width. For example, form 10 is described with regards to FIGS. 1 and 2 of Diaz. The combination of form 10 and self-adhesive strip 22 is described with regards to FIGS. 4 and 5 of Diaz. However, both form 10 and the combination of form 10 and self-adhesive strip 22 are depicted in these figures as having a length that is roughly equal to its width. Furthermore, nowhere else in Diaz is a structure shown or suggested in which the length is at least twice as long as the width, much less a strip of material that is substantially planar, that is crescent

shaped, and that has a length that is at least twice as long as the width, as required by applicant's independent claims 13 and 33.

For at least the foregoing reason, applicant respectfully submits that independent claims 13 and 33, and any claims depending therefrom, are patentable over Diaz. Accordingly, applicant respectfully requests that the 35 U.S.C. § 102(b) rejections of 13-15, 19, 21, 27, 33-37, and 39 with respect to Diaz be withdrawn.

X. Applicant's Reply to the 35 U.S.C. § 103(a) Rejection

The Examiner has rejected claim 38 under 35 U.S.C. § 103(a) as being unpatentable over Rosenberg, DeMarco, Diaz, or Valentin. The Examiner's rejection is respectfully traversed.

Claim 38 depends from independent claim 33. As shown above, independent claim 33 is patentable. Accordingly, applicant respectfully submits that dependent claim 38 is patentable at least because this claims depends from a patentable base claim and requests that the 35 U.S.C. § 103(a) rejection of this claim be withdrawn.

XI. Applicant's New Claims

Applicant has added new independent claim 40 and new dependent claims 41-44. The new claims are fully supported and justified by applicant's originally-filed specification and drawings and no new subject matter has been added. For example, see applicant's FIG. 3.

For at least the reasons discussed above in relation to independent claims 13 and 33, the new claims contain subject matter that is allowable over Rosenberg, DeMarco, Diaz, and Valentin, whether taken alone or in combination.

Conclusion

For at least the reasons set forth above, applicant respectfully submits that this application is in condition for allowance. Reconsideration and prompt allowance are respectfully requested.

Respectfully submitted,

/Maria Taku/

Maria A. Taku
Reg. No. 63,224
Agent for Applicant
KRAMER LEVIN
NAFTALIS & FRANKEL LLP
Customer No. 31013
1177 Avenue of the Americas
New York, New York 10036
Tel.: (212) 715-9100